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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,292	01/25/2002	Alfred Trzmiel	P6588.3US	1990
30008	7590	04/11/2005	EXAMINER	
GUDRUN E. HUCKETT DRAUDT			KEASEL, ERIC S	
LONSSTR. 53			ART UNIT	
WUPPERTAL, 42289			PAPER NUMBER	
GERMANY			3754	

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/057,292

Applicant(s)

TRZMIEL ET AL.

Examiner

Eric Keasel

Art Unit

3754

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5 and 7-51 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3 and 10-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-9 and 48-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 15, 2005 has been entered.

### *Response to Amendment*

2. The amendment to the claims filed on March 15, 2005 does not comply with the requirements of 37 CFR 1.121(c) because the status identifier to claim 51 (original) is incorrect (there was no claim 51 in the originally filed application). Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing*. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required*. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been

Art Unit: 3754

made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

However, to further prosecution, the claim will be treated as a previously presented claim. Any future submissions should provide proper status identifiers for all claims.

### ***Election/Restrictions***

3. Applicant’s election without traverse of Group IV, Species B in the paper filed January 16, 2004 is acknowledged.

4. Claims 2, 3, and 10-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups and/or Species, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed January 16, 2004.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5, 7-9, and 48-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The independent claims have been amended to recite that one or both PE elements act(s) directly through the spring(s) on the piston. Applicant's arguments state that the flexibility of the coil springs of Coleman allows the speed of the actuator and the speed of the piston to be different as the flexible springs are an indirect coupling of the motion of the actuator to the piston. Applicant has the same flexible springs; however, applicant has amended the claims to require a direct transmission of force between the actuator and the piston (i.e. the springs do not flex). This was not disclosed in the application as originally filed. This is a new matter rejection.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 5, 7-9, and 48-51 (as interpreted in a manner that is supported by the originally filed application) are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman (US Patent Number 4,866,091) in view of Weber (US Patent Number 5,911,245).

Coleman discloses a control device for hydraulic, mechanical, and hydraulic-mechanical components comprising a housing (see the embodiment of Figs. 4 and 5); at least one drive element (98, 114) arranged in the housing; further comprising a piston (92) arranged in the housing, wherein the drive element (98, 114) indirectly controls the piston (92); further comprising at least one pressure spring (100, 116) arranged in the housing, wherein the drive element (98, 114) engages the piston (92) with interposition of the at least one pressure spring (100, 116); wherein two of the drive elements (98, 114) are provided, wherein the two drive elements (98, 114) act indirectly on opposed ends of the piston (92); wherein the piston (92) is configured to be centered by a spring force in a center position when the two drive elements (98, 114) are not excited (see Fig. 4); wherein the drive element (98, 114) is a part of a directional control valve; wherein the directional control valve is directly controlled or pilot-operated; and the springs (100, 116) each against piston members (102, 118).

Coleman discloses the drive actuator as two solenoids on either side of the spool piston member rather than PE elements. Weber discloses that when the dynamic forces on the piston spool are generally equal and cancel each other out (as in the case of Coleman, Figs. 4 and 5), that PE device is an equivalent actuator to a solenoid actuator. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have replace the solenoids of Coleman with PE devices because one of ordinary skill in the art would have expected applicant's invention to perform equally well with PE devices or solenoids because Weber discloses that they are equivalent actuators, when the dynamic forces on the piston spool are generally equal and cancel each other out. Therefore, it would have been an obvious matter of design choice to modify Coleman to obtain the invention as specified in claims 1, 5, 7-9, and 48-51.

### ***Response to Arguments***

9. Applicant's arguments filed March 15, 2005 have been fully considered but they are not persuasive.

Applicant argues that the flexibility of the coil springs of Coleman allows the speed of the actuator and the speed of the piston to be different as the flexible springs are an indirect coupling of the motion of the actuator to the piston. The examiner agrees with the understanding of Coleman; however, applicant has the same flexible springs. Applicant's originally filed application does not support an invention in which the springs are rigid elements that directly transfer the movement of the actuator to the piston.

*Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 8 APR 2005

Eric Keasel  
Primary Examiner  
Art Unit 3754